

Yudong Zhu

S/N: 10/723,311

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "species II", "described by the lines 23-29 and 1-2, page 4 and 5 of the application." Though Applicant maintains that the proffered restriction is improper and unsustainable, claims 10-17 correspond to the paragraphs identified as describing "Embodiment II".

REMARKS

The Examiner identified three distinct "species" in the Specification. The "species" identified by the Examiner include Species I described by the lines 15-21, page 4 of the application, Species II described by the lines 23-29 and 1-2, page 4 and 5 of the application, and Species III, which the Examiner identified as "II", but Applicant believes "III" was intended, described by the lines 4-7, page 5 of the application.

The proffered restriction is improper for numerous reasons. First, though the Examiner acknowledged that the Amendment dated February 11, 2005, was received, the Examiner did not provide any remarks responsive thereto. As such, the current Office Action is not responsive.

Second, a proper restriction is to be predicated upon the contention that examination of the claims without restriction would be unduly burdensome. However, in the case at hand, the Examiner has already completed a substantive examination that resulted in the Office Action mailed December 15, 2004. While the Examiner may make a requirement for restriction at any time, "before making a restriction after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." MPEP §811. As the Examiner has already performed and completed a search and examination of all the claims, it is incredulous for the Examiner to now assert that a serious burden would result absent restriction.

Third, the Examiner improperly identified paragraphs within the application as "species". In particular, the three paragraphs cited by the Examiner as disclosing "Embodiments" of the present invention are found in the Brief Description of the Invention section of the Specification, wherein each Embodiment was alleged to be a separate species. However, even a cursory comparison of the cited paragraphs to the

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three independent claims of the present Application quickly elucidates that the language of each paragraph is substantially identical to that of one of the three independent claims. More specifically, lines 15-21, page 4 of the application (Embodiment I) corresponds to claim 1, lines 23-29 and 1-2, page 4 and 5 of the application (Embodiment II) corresponds to claim 10, and lines 4-7, page 5 of the application (Embodiment III) corresponds to claim 18. Thus, the Examiner has effectively restricted claims as species and has not identified actual embodiments restricted to species, which is contrary to accepted practice under the MPEP.

Section 806.04(e) of the MPEP is clear in that “[c]laims are never species.... Species are always the specifically different embodiments.” (Emphasis added and in original). Accordingly, the Examiner’s identification of the species amounts to a circumvention of the rule against identifying claims as species. In other words, it appears the Examiner has ignored that the claims are “different definitions of the same disclosed subject matter, varying in breadth and scope.” MPEP §806.03. Therefore, the present restriction attempts to circumvent this mandate by restricting between paragraphs of the application which are paragraph-form duplications of the independent claims.

In this regard, the Examiner has not clearly identified the “species” and has not stated any characteristics which distinguish between these “species.” See MPEP §809.02(a) (the Examiner must “[c]learly identify each... of the disclosed species to which claims are restricted. The species are preferably identified as... figures... or... examples”) (Emphasis added and in original). An inspection of the cited claims, beyond mere preamble language, reveals that the purported “species” are substantially interrelated. Thus, the Examiner could not provide a precise identification of the “species” or explain any distinguishable characteristics as between the cited claims. This failure to identify distinguishable characteristics indicates that the restriction required by the Examiner cannot be substantively supported.

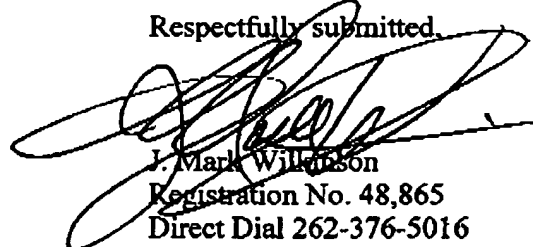
Such a manner of restriction is improper, unsupported, and must be withdrawn. As such, restriction should not be required in the present invention, and Applicant respectfully requests rejoinder of all claims, reading on each “Embodiment.”

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For all these reasons, Applicant respectfully requests rejoinder of all claims. As no basis of rejection remains. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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